

REMARKS

Claims 19 to 35 are now pending.

Applicants respectfully request that the Examiner state why claims 26 and 27 are rejected. These claims were rejected in the summary, but not in the Detailed Action.

Reconsideration is respectfully requested based on the following.

As to the objections to the drawings in paragraph (1) of the Office Action, a Replacement Sheet for the Figure 5 accompanies this response, as suggested. No new matter has been added, and the Replacement Sheet (which adds legibility of Figure 5) is supported by the present application, including the specification. Entry and approval is respectfully requested.

With respect to paragraph (2) of the Office Action, claims 19 to 22, and 28 to 35 were rejected under 35 U.S.C. § 102(b) as anticipated by Goodwin et al., U.S. Patent Application 2002/0194906 (the “Goodwin” reference).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

The text cited at page 3 of the “Goodwin” reference (resonator 32) does not identically disclose (nor even suggest) the features of claim 19. The “Goodwin” reference merely concerns a torsional plate etched or cut from a planar member that is machined from a semiconductor substrate (¶ 0035). The “Goodwin” reference does not even mention a resonator that includes a piezoelectric component. The cited portions of the “Goodwin” reference do not identically disclose (nor even suggest) the feature of *a piezoelectric component configured as a resonator*, as provided for in the context of claim 19.

Accordingly, for these reasons, claim 19 is allowable, as are its dependent claims 19 to 22.

The text cited at page 4 of the “Goodwin” reference (heating electrode 65) does not identically disclose the features of claim 31. The heating electrode referred to at ¶ 0040 of “Goodwin” is used in measuring the thermal conductivity of a fluid -- not for measuring viscosity of a liquid.

Claims 32 to 35 depend from claim 31 and are therefore allowable for the same reasons as claim 31.

With respect to paragraph (3) of the Office Action, Claims 23 to 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over Goodwin et al., U.S. Patent Application 2002/0194906 in view of U.S. Pat. No. 5,958,269 to Makoto Suzuki et al (the “Suzuki” reference).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some

articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 23 to 25 depend from claim 19 and are therefore allowable for essentially the same reasons, since the secondary reference does not cure – and is not asserted to cure – the critical deficiencies of the primary Goodwin reference. It is therefore respectfully requested the obviousness rejections be withdrawn.

In summary, all of pending claims 19 to 36 are allowable.

CONCLUSION

In view of the foregoing, all of pending claims 19 to 35 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,
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